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The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte ZEV Z. LERMAN

Appeal No. 95-2537

Application 08/130,868¹

MAILED

OCT 30 1995

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

HEARD: October 12, 1995

Before HARKCOM, Vice-Chief Administrative Patent Judge, and
MEISTER and PAK, *Administrative Patent Judges*.

MEISTER, *Administrative Patent Judge*.

DECISION ON APPEAL

Zev Z. Lerman (the appellant) appeals from the final rejection of claims 1 and 5-15², the only claims remaining in the application. We affirm-in-part.

¹ Application for patent filed October 4, 1993.

² Claims 1 and 5-15 have been amended subsequent to final rejection.

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The appellant's invention pertains to a vertical organizer mounted between a pair of telecommunication relay racks. Independent claim 1 is further illustrative of the appealed subject matter and a copy thereof, as it appears in the appendix to the appellant's brief, is appended to this opinion.

The references of record relied on by the Examiner are:

Brey et al. (Brey)	4,665,546	May 12, 1987
Salmon	4,715,502	Dec. 29, 1987

Claim 15 stands rejected under 35 U.S.C. § 102(a), (b) or (e) as being anticipated by Brey.³

Claims 1 and 5-14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Brey in view of Salmon. According to the examiner it would have been obvious to form the vertical organizer of Brey from two pieces which may be fastened together with a splice in view of the teachings of Salmon.

Rather than reiterate the arguments of the appellant and the examiner in support of their respective positions, reference is made to the brief, reply brief and answer for the full exposition thereof.

³ Inasmuch as the patent to Brey issued more than one year prior to the filing date of the instant application (i.e., is a statutory bar), 35 U.S.C. § 102(b) is the appropriate statutory basis.

OPINION

At the outset we note that the examiner has stated that claims 1 and 5-15 "stand or fall together." We observe, however, that the appellant has separately argued the patentability of these claims.

We have carefully reviewed the appellant's invention as described in the specification, the appealed claims, the prior art applied by the examiner and the respective positions advanced by the appellant in the brief and reply brief and by the examiner in the answer. As a consequence of this review, we will sustain the examiner's rejections of claim 15 under 35 U.S.C. § 102(b) and claims 1, 5, 6, 9, 10 and 12 under 35 U.S.C. § 103. We will not, however, sustain the examiner's rejection of claims 7, 8, 11, 13 and 14 under 35 U.S.C. § 103.

Considering first the rejection of claim 15 under 35 U.S.C. § 102(b) as being anticipated by Brey, it is the appellant's position that Brey does not disclose a vertical trough having an open side, much less a vertical trough having "a plurality of split rings mounted on the side opposite the open side." We disagree. The terminology in a pending application's claims is to be given its broadest reasonable interpretation (*see In re Zletz*, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989)) and limitations from a pending application's specification will not be read

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into the claims (*see Sjolund v. Musland*, 847 F.2d 1573, 6 USPQ2d 2020 (Fed. Cir. 1988)). Moreover, anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. *See Verdegaal Brothers Inc. v. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987). A prior art reference anticipates the subject matter of a claim when that reference discloses, either expressly or under the principles of inherency, each and every element set forth in the claim (*see In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994) and *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990)); however, the law of anticipation does not require that the reference teach what the appellant is claiming, but only that the claims on appeal "read on" something disclosed in the reference (*see Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983)).

Here, the examiner has taken the position that in Brey the element 66 forms an open trough while the elements 64 correspond to the claimed split rings. In our view, the examiner's position is well-taken. Viewing Figs. 2, 3 and 4, it is readily apparent that Brey provides a vertically-oriented elongated member (unnumbered) which is of a generally rectangular shape. Attached to

this rectangular member on one side are a plurality of split rings 64 and on the other side a plurality of spaced, "open" channel elements which, taken in conjunction with the rectangular member, form a channel 66 (note column 7, line 3) that has an "open" side. Noting that Webster's dictionary⁴ defines a "trough" as --[2]b (1) : a long and narrow or shallow channel or depression (as between waves or hills) ... c : a usu. recessed channel enclosing and concealing utilitarian structural elements (as piping or wiring) --, we are of the opinion that the channel 66 of Brey can be considered to be a "trough" as broadly claimed. It is readily apparent from Fig. 3 of Brey that split rings 64 are mounted on the side of the trough 66 "opposite the open side" as claimed.

In view of the foregoing, we will sustain the examiner's rejection of claim 15 under 35 U.S.C. § 102(b) as being anticipated by Brey.

Turning to the rejection of claims 1, 5, 6, 9, 10 and 12 under 35 U.S.C. § 103 as being unpatentable over Brey in view of Salmon, it is the appellant's position that

[t]here is no suggestion in either Brey or Salmon that Salmon's construction which allows adjustment of the width of a telephone equipment rack be applied to

⁴ Webster's Third New International Dictionary of the English Language, Unabridged, G. & C. Merriam Co., Springfield, MA, 1981.

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Brey's vertical jumper channel. The concept of improving Brey's channel is nowhere suggested in either of the references. Salmon does not even disclose a vertical organizer. Brey's disclosure of his vertical channel is minimal and is largely dependent on the drawings. There is no suggestion of the combination made by the Examiner who used the applicant's teaching as a blueprint to pick out bits and pieces of the references to find a basis for rejection.

Claim 1 recites the specific limitation of; "a lower section, an upper section aligned with the lower section, and a splice joining the upper section to the lower section." This specific arrangement is not shown in Brey. The Examiner makes a quantum leap and takes the position that it would be obvious to take Salmon's horizontal frame construction and utilize it in the Brey vertical channel. If the Salmon construction were to be used by Brey, it would be used in the frame rather than in the vertical channel. (see brief, pages 13 and 14)

We are unpersuaded by the appellant's arguments. While there must be some teaching or suggestion to combine existing elements to produce the claimed device (*see In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992)), it is not necessary that the cited references or prior art specifically suggest making the combination (*see In re Nilssen*, 851 F.2d 1401, 7 USPQ2d 1500 (Fed. Cir. 1988)). Rather the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. *See In re Young*, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991) and *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Here, as we have noted above with respect to the Section 102 rejection, Brey in Figs. 2, 3 and 4 discloses a vertical organizer having an elongated generally rectangular member (unnumbered) with split rings 64 attached to one side and spaced, "open" channel elements attached to the other side in such a manner so as to define a channel 66. Brey, however, does not disclose upper and lower sections joined together by a splice. On the other hand, Salmon discloses elongated channel-shaped frame sections which are joined together by various splices (see, e.g., Figs. 2, 3, 14 and 15). In column 3, lines 32 *et seq.*, Salmon lists various advantages attributable to joining his sections together by means of a splice, including the advantage of suitability "to be broken down in a highly compact nested arrangement thus minimizing transportation cost." This statement would have provided more than ample motivation or suggestion to the artisan to form the elongated vertical organizer of Brey in sections joined together by a splice in order to achieve Salmon's expressly stated advantage of providing a compact arrangement for purposes of shipment and thus minimize transportation costs. As to the appellant's contention that Salmon would only teach providing a splice in a frame, as distinguished from a vertical channel or organizer, we observe that all of the features of the

secondary reference need not be bodily incorporated into the primary reference (*see In re Keller, supra*), and the artisan is not compelled to blindly follow the teaching of one prior art reference over the other without the exercise of independent judgment (*see Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F.2d 881, 221 USPQ 1025 (Fed. Cir. 1984)). In our view, the teachings of Salmon would have fairly suggested to form any elongated channel member (such as the vertical organizer of Brey) in sections joined together by means of a splice for the purpose of achieving ease of shipment. With respect to claim 5, the vertical organizer of Brey, as modified in accordance with the teachings of Salmon, would result in a device having a splice "conforming" to the interior of Brey's trough as broadly claimed. With respect to claims 9, 10 and 12, the appellant further argues that there is nothing in the combined teachings of Brey and Salmon which would suggest "a pair of runners fixed to the opposed edges of the vertical back." We must disagree. In Brey, the sides (see Fig. 3) of the "channel elements" (which we referred to in the Section 102 rejection) can be considered to be "runners" affixed to edges of the unnumbered rectangular element depicted in Figs. 2 and 4.

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Applying the test for obviousness⁵ as set forth in *In re Keller, supra*, we are of the opinion that the subject matter defined by claims 1, 5, 6, 9, 10 and 12 is nothing more than what the combined teachings of Brey and Salmon would have suggested to one of ordinary skill in this art. This being the case, we will sustain the examiner's rejection of these claims under 35 U.S.C. § 103.

Considering last the rejection of claims 7, 8, 11, 13 and 14, the appellant argues that there is nothing in the combined teachings of Brey and Salmon which would suggest a fastener extending through the splice, trough and upright in the manner claimed. We agree. It is well settled that in order to establish a *prima facie* case of obviousness the prior art teachings must be sufficient to suggest to one of ordinary skill in the art making the modification needed to arrive at the claimed invention. See, for example, *In re Lalu*, 747 F.2d 703, 223 USPQ 1257 (Fed. Cir. 1984). Here, the examiner has failed to identify anything in the relied on prior art which would suggest the

⁵ The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.

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claimed fastening arrangement and we find nothing. Inasmuch as the examiner has failed to provide a factual basis upon which the legal conclusion of obviousness may be reached (*see In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967)), we will not sustain the examiner's rejection of claims 7, 8, 11, 13 and 14 under 35 U.S.C. § 103 based on the combined disclosures of Brey and Salmon.

In summary:

The examiner's rejection of claim 15 under 35 U.S.C. § 102(b) and claims 1, 5, 6, 9, 10 and 12 under 35 U.S.C. § 103 are affirmed.

The examiner's rejection of claims 7, 8, 11, 13 and 14 under 35 U.S.C. § 103 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR 1.136(a).

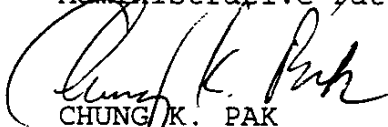
AFFIRMED-IN-PART



GARY V. HARICOM, Vice-Chief
Administrative Patent Judge



JAMES M. MEISTER
Administrative Patent Judge



CHUNG K. PAK
Administrative Patent Judge

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CLAIM 1

1. A vertical organizer mounted between a pair of telecommunication relay racks, each of said racks being aligned with the other rack, each rack having a backside in substantially the same plane as the backside of the other rack, each of said racks having an upright defining a respective side positioned adjacent to and spaced from an upright of the other rack defining an adjacent side of the other rack, said vertical organizer including a vertical trough having opposed sides fixed to adjacent uprights, said trough having an open side on the same side as the backsides of said racks cooperating with the upright of each of the adjacent racks to provide a channel for positioning a plurality telecommunication cables between the racks, said trough including; a lower section, an upper section aligned with the lower section, and a splice joining the upper section to the lower section, said upper and lower sections extending between and fixed to adjacent uprights.